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09/871,241	05/30/2001	Philip D. Lapsley	8514-50	8211

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PORTLAND, OR 97204

EXAMINER

MALHOTRA, SANJEEV

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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01/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/871,241

Applicant(s)

LAPSLEY ET AL.

Examiner

Sanjeev Malhotra

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the remarks and arguments filed on November 7, 2007 and April 12, 2007 for the application titled: "Biometric Financial Transaction System and Method". Statements and Affidavits submitted by the Applicant on November 7, 2007 regarding the changes in assignment and ownership have been reviewed and entered.

Claims Status

2. Based on the Applicant's response dated November 7th, 2007 and April 12th, 2007, the Examiner has determined the following to be the latest status of the Applicants claims:

Claims 1-29 were previously submitted for examination.

Claims 1, 9-10 and 20 are 'currently amended'.

Claims 30-31 have now been submitted as 'new claims' for prosecution.

As explained below in this Office Action, the 'new' Claims 30-31 have been withdrawn due to original presentation.

Therefore, Claims 1-29 are currently pending for examination.

Election/Restriction

3. Newly submitted Claims 30 and 31 are directed to an invention that is independent or distinct from the invention originally claimed for the

following reasons: The original independent Claims 1 and 20, and their dependent claims 2-19 and 21-29, respectively, are directed to "a method (claim 1) and system (claim 20)"; while the 'new' independent Claim 30, and its dependent claim 31, are directed to "a method". Since the applicant has already received an action on the merits for the originally presented invention (claims 1-29), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, 'new' Claims 30-31 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Abstract Objections

4. The Abstract objections are withdrawn and the Revised Abstract submitted by the Applicant on April 12, 2007 is hereby accepted as having 147 words per count done by the WORD software.

Oath/Declaration

5. The Oath/ Declaration objections are withdrawn and the Substitute Oath/ Declaration submitted by the Applicant on April 12, 2007 is hereby accepted.

Drawing Objections

6. The Drawings objections are withdrawn and the Replacement Drawings submitted by the Applicant on April 12, 2007 are hereby accepted.

Specification Objections

7. Based on the Applicant's amendments to the Specification, the previous objections noted in the Office Action of March 22, 2007 are hereby withdrawn and the amendments to the Specification are hereby accepted.

Claim Objections

8. Claim 1, and its dependent claims 2-11, are objected to due to the following informalities:

Claim 1, step (a) recites three sub-steps again: (a), (b) and (c) in lines 11-14, which is a repetition of the numbering of claims. Examiner suggests numbering the three sub-steps (a), (b) and (c) as (i), (ii) and (iii), respectively, to distinguish them from the four steps already numbered as (a), (b), (c) and (d). Examiner has read them to be sub-steps (i), (ii) and (iii).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Based on the Applicant's amendments to Claims 1, 8 and 9, the previous objections noted in the Office Action of March 22, 2007 are hereby withdrawn and the amendments to these claims are hereby accepted.

11. Claim 10, and its dependent Claim 11 (both are identified as 'Original' claims in the most recent submission of September 6th, 2007), are rejected again under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "the container" in 2nd Line of this claim. There is insufficient antecedent basis for this limitation in the claim. Further, as noted in the previous Office Action, the Examiner respectfully notes that this Claim has Not been examined the way Applicants have recited it.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In accordance with the revised Interim Guidelines for Subject Matter Eligibility (please refer to web link, http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html for details), a claimed invention must satisfy the requirement that it be directed to a "practical application" which is to mean "the claimed invention physically transforms an article or physical object to a different state or thing, or the claimed invention otherwise produces a useful, concrete, and tangible result".

Since, the physical transformation test is not relevant to the instant claims, the proper test to determine whether the claimed invention satisfies the "practical application" is whether the claimed invention produces a useful, concrete and tangible result. The focus is on the result of the claims as a whole, not the individual steps or structure used to produce the result.

A useful, concrete and tangible result must be either specifically recited in the claims or flow inherently therefrom. To flow inherently therefrom, it must occur. If there is a reasonable exception or it is merely likely that it would occur, it does not "flow inherently therefrom" and the claim would need to be amended to specifically recite the result.

Exemplary analysis of independent Claim 1 is provided which applies to

all of its dependent Claims 2-11.

Claim 1 recites a method for “distributing billing-related usage data records” as recited in first line. It is noted that the usage data is received from an assembly pool of many telecommunication service providers as recited in the preamble of this claim. The claimed invention identifies [step (a)] records (data) by three matching criteria (sub-steps) ---that are vague and Not defined clearly as identified above in rejection of Claim 1 under 35 USC 112--- for further processing. Further, the new sub-step (ii) added as a current amendment that recites: “related records related to source records with” needs to be reworded or it needs proper clarification about ‘records’, since this sub-step is recited yet for another type of ‘records’ to begin with, as in: “the identified records comprising one or more of:” and then lists sub-steps (i), (ii) and (iii). Examiner also seeks identification of particular paragraphs in the Specification for current amendments by the Applicant, especially for all Claim 1 amendments. The claimed invention then matches [in step (b)], assembles [in step (c)] and distributes [in step (d)] such records based on some criteria, but these three steps [(b), (c) & (d)] are also vague and have Not been defined clearly as identified above in the rejection of Claim 1.

The amended Claim 1 explicitly added new sub-steps (i), (ii) and (iii) as part of step (a) of “identifying records”, but Claim 1 does not properly define the sub-steps as recited therein. Additionally, examined claims do not positively recite what is needed to produce a tangible, concrete and useful result of the claimed invention, since, for example, no computer is mentioned in these claims.

In the present form, the claimed invention does not produce a tangible result, because sorting, assembling, interactively matching, etc. do not produce a real world result, because the claimed invention merely provides capabilities to the plurality of service providers to follow these steps, but the claims as a whole do Not produce a tangible, concrete and useful result. The recitation of steps of “assembling” and “purging” records in a database is too broad to be interpreted as a method (process or processes) that actually alters the state of the database records for distribution, a real world or tangible act as the Applicant suggests.

The claimed invention does not produce useful result as evidenced by the lack of utility (i.e. usefulness) of the result of the claimed invention. To be "useful", the claimed invention as a whole must satisfy the following utility requirements of 101. The claimed invention must recite utility that is :

- o specific,
- o substantial, and
- o credible utility.

In the instant case, the claimed invention “distributes assembled records of billing data to the appropriate billing related systems” without ascertaining what is the specific and real-world usefulness of these records. Examiner notes that the recently added ‘new’ Claims 12-20 have defined some limitations, such as collect or outcollection, which when added to the examined claims may render them useful.

Therefore, it is concluded that the claimed invention does not meet the requirements of being “useful, concrete and tangible” and is directed to a non-statutory subject matter. The foregoing analysis applies to all method claims and

dependent claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-11, as best understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,850,974 issued to Schweitzer et al. (hereinafter "Schweitzer") claiming priority from November 20, 1997 and titled: "System, Method and Computer Program Product for Constructing a Network-based Filtering and Aggregating Platform" in view of US Patent No. 6,813,645 issued to Meyer, Jeffrey D. (hereinafter "Meyer") filed on May 24, 2000 and titled: "System and Method for Determining a Customer Associated with a Range of IP Addresses by Employing a Configurable Rule Engine with IP Address Range Matching".

With respect to **claim 1**, Schweitzer teaches identifying records within the single assembly pool for further processing by identifying one or more field values within the usage data record that match one of a predefined record type associated with one or more of the plurality of external network collection points, the identified records comprising

one or more of: (i) a source record with one or more field values matching the predefined record type, (ii) related records related to the source records with one or more field values matching the predefined record type, and (iii) records unrelated to the predefined record type; (see for example column 6, lines 41-45, column 13, lines 56-62 and column 14, lines 12-17).

Schweitzer teaches as disclosed above, but it does not explicitly teach about “one of a predefined record type associated with one or more of the plurality of external network collection points”, but Meyer teaches it. (see Meyer Abstract and Summary, and FIGs. 2,3, & 4 and text, esp. C 10, ~L 22-32)

Meyer teaches about Rule Engine 96 as a predefined aggregation scheme or set of rules for aggregation of data/records from multiple sources, for example, data based on consumer usage of telecommunications network. It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Schweitzer with the teachings of Meyer to generate billing data based on the predefined aggregation scheme of Meyer. The motivation to combine would be to provide a more efficient aggregation of data/records and a better billing system.

With respect to **claim 1**, Schweitzer teaches matching identified records in accordance with a matching criteria, the matched records comprising source records and related records of one of the predetermined record type to create an assembled record of billing data (see for example column 7, lines 12-15).

With respect to **claim 1**, Schweitzer teaches assembling one or more matched records of one of the predetermined record types in accordance with an assembly criteria for the predetermined record type to create an assembled record of billing data (see for example column 7, lines 15-17).

Examiner notes that the “threshold” reached by the matched or accumulated records represents Applicant’s assembly criteria. Examiner notes that this meets Applicant’s definition found in the Specification on page 39, paragraphs 137-138.

With respect to **claim 1**, Schweitzer teaches distributing assembled records of billing data to the appropriate billing related systems (see for example column 3, lines 4-21). Also, the Examiner notes that the distribution of billing¹ records is inherent as taught by Schweitzer.

Examiner notes that not limited to these quotes herein, Schweitzer states: “The system gathers, correlates, and transforms data from routers, switches, firewalls, authentication servers, LDAP, Web hosts, DNS, and other devices to create comprehensive usage and billing records.” (please see Column 3, lines 8-12), and it further adds: “The system transforms raw transaction data from network devices into useful billing records through policy-based filtering, aggregation, and merging. The result is a set of detail records (DRs).” (please see Column 3, lines 13-16), and Schweitzer concludes: “Thus, DRs can be easily integrated with existing Customer Care and Billing (CCB) systems.” (please see Column 3, lines 20-21).

With respect to **claim 2**, Schweitzer teaches interactively receiving one or more of an identifying rule, matching criteria and assembly criteria from a user to modify a predefined record type (see for example column 2, lines 25-27).

¹ billing is defined as a noun meaning: “an act or instance of preparing or sending out a bill or invoice” according to the Dictionary.com Unabridged (v1.1), by Random House, Inc. 2006.

With respect to **claim 3**, Schweitzer teaches wherein assembling matched records further comprises referencing a volume-based assembly criteria (see for example column 7, lines 15-17).

With respect to **claim 4**, Schweitzer teaches wherein assembling matched records further comprises referencing a time-based assembly criteria (see for example column 8, lines 64-67).

With respect to **claim 5**, Schweitzer teaches wherein assembling matched records further comprises referencing an expression-based assembly criteria (see for example column 7, lines 17-22).

With respect to **claim 5**, Schweitzer teaches wherein distributing the assembled records comprises distributing portions of the assembled records to appropriate billing related systems (see for example Column 3, lines 4-21).

Examiner notes that not limited to these quotes herein, Schweitzer states: "The system gathers, correlates, and transforms data from routers, switches, firewalls, authentication servers, LDAP, Web hosts, DNS, and other devices to create comprehensive usage and billing records." (please see Column 3, lines 8-12), and it further adds: "The system transforms raw transaction data from network devices into useful billing records through policy-based filtering, aggregation, and merging. The

result is a set of detail records (DRs)." (please see Column 3, lines 13-16), and

Schweitzer concludes: "Thus, DRs can be easily integrated with existing Customer Care and Billing (CCB) systems." (please see Column 3, lines 20-21).

With respect to **claim 6**, Schweitzer teaches interactively associating an identifying rule, matching criteria and assembly criteria with a network collection point for a predefined record type (see for example column 6, line 65 through column 7, line 8).

With respect to **claim 7**, Schweitzer teaches wherein assembling matched records further comprises assembling one output record containing a matched source record and related record (see for example column 9, lines 13-17).

With respect to **claim 8**, Schweitzer teaches wherein assembling matched records further comprises assembling multiple output records, each containing a matched source record and related record.

With respect to **claim 9**, Schweitzer teaches wherein assembling matched records further comprises assembling multiple output records, each selected pairing of a matched record and a plurality of related records.

Examiner notes that the assembly of multiple output records taught by Schweitzer represents both a one to one matching and a one to many matching. Therefore, it is the

position of the Examiner that Schweitzer anticipates the limitations recited in both claims 8 and 9.

With respect to **claim 10**, Schweitzer teaches wherein assembling matched records further includes purging related records from the container (see for example column 6, lines 60-64).

Examiner notes that the Filter of Schweitzer represents Applicant's purging.

With respect to **claim 11**, Schweitzer teaches purging source records in accordance with a purge option (see for example column 6, lines 60-64).

Examiner notes that the Filter of Schweitzer represents Applicant's purging.

Response to Arguments

16. Applicant's REMARKS and Arguments dated September 6th, 2007 with respect to Claims 1-11 have been carefully considered, but they are not persuasive. Examiner notes that the Application No. on page 1 of "Amendment and Response" of September 6th, 2007 and header of many pages have been wrongly cited as for Application No. "10/190,884", when it should be actually Application No. "10/190,844".

In the last Office Action mailed on March 22nd, 2007, the Examiner had put forth the arguments for rejection of Claims 1-11 under 35 USC 102; and the current amendments by the Applicant has led the Examiner to reject the amended claims 1-11

under 35 USC 103(a), and Examiner respectfully disagrees with the arguments submitted. Further, the Applicants are informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply.

Additionally, Examiner notes that while the current amendments to Claims 1, 2, 6, 8 and 9 may have overcome their previous 35 USC 102 rejection, these amendments to Claims 1, 2, 6, 8 and 9 in the Applicant's September 6th, 2007 response have been considered and rejected under 35 USC 103(a) now. Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Conclusion

17. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure and review for not traversing already issued patents by the claims of the current invention of the Applicant:

- US Patent No. 6,032,132 issued on February 29, 2000 to Nelson, Nickolas B. and assigned to CSG Systems, Inc.
- US Patent No. 6,119,011 issued on September 12, 2000 to Borst et al. and assigned to Lucent Technologies Inc.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

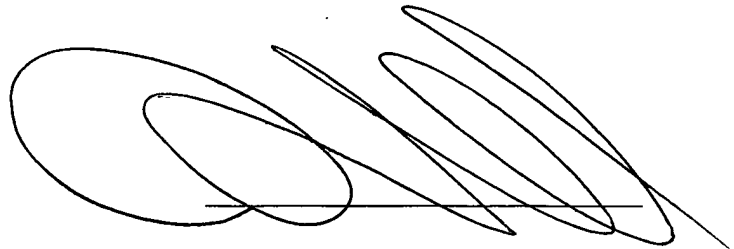
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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20. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

SM

January 7, 2008

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the end, positioned above the printed name.

James P. Trammell, SPE

Supervisory Patent Examiner